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Yoshihito Ikeda

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EXAMINER

HANLEY, SUSAN MARIE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: YOSHIHITO IKEDA and HIROMI SATOU

Application No. 10/018,770
Technology Center 1600

Mailed: July 31, 2009

Before QUITA GOULD *Supervisory Paralegal Specialist*
GOULD, *Supervisory Paralegal Specialist*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on July 27, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

APPEAL BRIEF: SUMMARY OF CLAIMED SUBJECT MATTER

Appellants filed an Appeal Brief dated November 14, 2005. The Appeal Brief is not in compliance with 37 C.F.R. § 41.37(c), effective September 13, 2004.

According to 37 C.F.R. § 41.37(c)(v), an Appeal Brief must include the following:

(v) *Summary Of Claimed Subject Matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of Claimed Subject Matter,” appearing on page 3 of the Appeal Brief, is deficient because it maps independent claim 1 to line numbers non-existent in the Specification. In addition, the “Summary of Claimed Subject Matter” does not map independent claim 19. Claim 19 is listed in independent form in the Appeal Brief’s Claims Appendix.

MPEP § 1205.03 states in part:

(B) When the Office holds the brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject matter as required by 37 CFR

41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

EXAMINER'S ANSWER: HEADINGS

A review of the file indicates that the Examiner's Answer, filed May 1, 2006, does not comply with the guidelines provided in MPEP § 1207.02 because it does not contain all of the required heading items. Specifically, the Examiner's Answer must contain the following heading items in the following order:

- (1) *Real party in interest.*
- (2) *Related appeals and interferences.*
- (3) *Status of claims.*
- (4) *Status of amendments After Final.*
- (5) *Summary of claimed subject matter.*
- (6) *Grounds of rejection to be reviewed on appeal.*
- (7) *Claims Appendix.*
- (8) *Evidence Relied Upon.*
- (9) *Grounds of Rejection.*
- (10) *Response to Argument.*
- (11) *Related Proceedings Appendix.*

An in-depth review of the Examiner's Answer indicates that the following sections are missing from the Examiner's Answer:

- (11) "Related Proceedings Appendix."

CONCLUSION

Accordingly, it is ORDERED that the application is returned to the Examiner:

(1) to hold the Appeal Brief, filed November 14, 2005, defective, as required by 37 C.F.R. § 41.37(d);

(2) to notify the Appellants to submit a “paper” which corrects the Appeal Brief’s Summary of Claimed Subject Matter under 37 C.F.R. § 41.37(c)(1)(v);

(3) to submit the correct heading and text missing from the Examiner’s Answer on a PTO-90; and

(4) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

QG/bim

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